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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,534	09/25/2003	Jinru Bian	03010US	5465
7590 11/22/2004				
Rodel Holdings, Inc. Suite 1300 1105 North Market Street Wilmington, DE 19899		EXAMINER MARCHESCHI, MICHAEL A		
		ART UNIT 1755 PAPER NUMBER		

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/670,534

Applicant(s)

BIAN ET AL.

Examiner

Michael A Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/12/04.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to a solution for polishing which can contain an abrasive, classified in class 51, subclass 307.
- II. Claims 5-8, drawn to a solution for polishing which **does not** can contain an abrasive, classified in class 510, subclass 175.
- III. Claims 9-10, drawn to a polishing method, classified in class 438, subclass 692.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product, such as one that specifically contains an abrasive. In addition, the claimed method does not require the particulars of the group I claims.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product, such as one that specifically contains an abrasive. In addition, the claimed method does not require the particulars of the group II claims.

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Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions, and different effects (MPEP § 806.04, MPEP § 808.01).

Because these inventions are distinct for the reasons given above and (1) have acquired a separate status in the art as shown by their different classification, (2) have acquired a separate status in the art because of their recognized divergent subject matter, and (3) the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

During a telephone conversation with Blake T. Biederman on 11/15/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-4. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found

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allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite as to the phrase "selected from the group **comprising**" because this does not define the claim in proper Markush language and therefore should be changed to "selected from the group **consisting of**"

Claim 2 is indefinite as to the way it is drafted because it is not defined in a clear and **concise** manner because the examiner is unclear as to if (1) this is defining that the barrier removal agent **is** the imine derivative and is present in the recited amount or if (2) the barrier

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removal agent is a mixture of the two recited components wherein the imine derivative of the mixture is present in the recited amount . If scenario 1 is intended to be claimed , this should be changed to “wherein the barrier removal agent is present in an amount of 0.1-10 weight percent and is the imine derivative compound.

Claim 3 is indefinite as to the phrase “selected from the group comprising” because this does not define the claim in proper Markush language and therefore should be changed to “selected from the group consisting of”

Claim 4 is indefinite as to the phrase “selected from the group comprising” (both occurrences) because this does not define the claim in proper Markush language and therefore should be changed to “selected from the group consisting of”

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In the following claims, CDO means carbon doped oxide (see section [0063] of the specification).

Claims 1, 3 and 4 are directed to an invention not patentably distinct from claim 4 of commonly assigned publication number 20041071265. Specifically, the copending claims claim a composition which comprises 0.1-15% of an oxidizing agent and 0.01-5% of an azole inhibitor.

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Although the claims do not define the oxidizing agent and azole, the claimed materials are obvious because "A generic disclosure renders a claimed species *prima facie* obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)". The claimed materials are known oxidizers and azole materials. With respect to the selectivity, it is the examiners position that although the reference fails to literally define this, this composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned publication number 20041071265, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being obvious over Ye et al. (publication number 20041071265).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The reference teaches in sections [0013], [0017] [0023], [0037] and claim 4, a polishing composition which comprises 0.1-15% of an oxidizing agent (claimed material) and 0.01-5% of an azole inhibitor (imidazole). Although the reference does not literally define the selectivity, this aspect is obvious because it is the examiners position the composition of the reference is



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expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary. In addition, the reference teaches that tantalum nitride and CDO can be polished.

Claims 1-4 are directed to an invention not patentably distinct from claims 1-7 of commonly assigned publication number 20030181345. Specifically, the copending claims claim a composition which comprises 0-25% of an oxidizing agent, 0.01-12% of a tantalum removal agent (claimed materials) and 0-15% of an azole inhibitor. Although the claims do not define the oxidizing agent and azole, the claimed materials are obvious because **"A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".** The claimed materials are known oxidizers and azole materials. With respect to the selectivity, it is the examiners position that although the reference fails to literally define this, this composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned publication number 20030181345, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case

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qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being obvious over Bian (publication number 20030181345).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in

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accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The reference teaches in sections [0014]-[0017], [0036] and the claims, a polishing composition which comprises 0-25% of an oxidizing agent (claimed materials), 0.01-12% of a tantalum removal agent (claimed materials) and 0-15% of an azole inhibitor (imidazole). Although the reference does not literally define the selectivity, this aspect is obvious because it is the examiners position the composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary. In addition, the reference teaches that tantalum nitride and CDO can be polished.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being obvious over Wang et al. (985).

The reference teaches in sections [0042]-[0044] and [0052]-[0056], a polishing composition which comprises 0.005-25% of a peroxide oxidizing agent, 0.005-1% imidazole, and 0.01-about 0.1 of peracetic acid (claimed oxidizer). The composition is used to polish tantalum nitride and CDO.

Although the claims do not literally define hydrogen peroxide, the teaching of a peroxide oxidizing agent makes this material obvious because **"A generic disclosure renders a claimed**

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**species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".** In addition, the reference uses peracetic acid which is one of the claimed oxidizers. Although the reference does not literally define the selectivity, this aspect is obvious because it is the examiners position the composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary. In addition, the reference teaches that tantalum nitride and CDO can be polished.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being obvious over Liu et al. (320).

The reference teaches in sections [0033], [0044], [0045], [0061] and [0062], a polishing composition which comprises 0.001-5% imidazole, and 0.01-about 90% of an oxidizing agent (claimed materials). The composition is used to polish tantalum nitride and CDO.

Although the reference does not literally define the selectivity, this aspect is obvious because it is the examiners position the composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary. In addition, the reference teaches that tantalum nitride and CDO can be polished.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being obvious over WO 01/12740.

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The reference teaches in the abstract, on page 3, line 32-page 4, line 32, page 7, lines 14-18, a polishing composition which comprises 0.5-10% of an oxidizing agent (claimed materials), 0.05-10% of a polishing additive (imines). The composition is used to polish tantalum nitride and CDO. Example 3 also teaches a composition which comprises 2.5% of an oxidizing agent and 0.5 or 1% of a polishing additive (guanidine nitrate).

Although the reference does not literally state, "imine derivatives, the claimed materials are obvious because **"A generic disclosure (imine) renders a claimed species (imine derivatives) prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".** In addition, example 3 of the reference teaches a composition that comprises the same components (oxidizing agent <sup>an</sup> guanidine nitrate). Although the reference does not literally define the selectivity, this aspect is obvious because it is the examiners position the composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary. In addition, the reference teaches that tantalum nitride and CDO can be polished.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being obvious over EP 1072662 A1.

The reference teaches in the abstract, section [0010]-[0020] and the claims, a polishing composition which comprises 0.1-10% of an oxidizing agent (claimed materials) and 0.01-30% of a polishing accelerator (claimed materials).

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Although the reference does not literally define the selectivity, this aspect is obvious because it is the examiners position the composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being obvious over Lee et al. (834).

The reference teaches in the abstract, column 4, line 3-column 5, line 68 and the claims, a polishing composition which comprises 0.1-10% of an oxidizing agent (claimed materials) and 0.01-30% of a polishing accelerator (claimed materials).

Although the reference does not literally define the selectivity, this aspect is obvious because it is the examiners position the composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3 and 4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/376,059 (publication number 20041071265). Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the composition of the copending claims would render obvious the instant claims.

The copending claims claim a composition which comprises 0.1-15% of an oxidizing agent and 0.01-5% of an azole inhibitor. Although the claims do not define the oxidizing agent and azole, the claimed materials are obvious because **"A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".** The claimed materials are known oxidizers and azole materials. With respect to the selectivity, it is the examiners position that although the reference fails to literally define this, this composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/396,013 (publication number 20030181345). Although the conflicting claims are not identical, they are not patentably distinct from each other because the reduction to practice of the composition of the copending claims would render obvious the instant claims.

The copending claims claim a composition which comprises 0-25% of an oxidizing agent, 0.01-12% of a tantalum removal agent (claimed materials) and 0-15% of an azole inhibitor. Although the claims do not define the oxidizing agent and azole, the claimed materials are obvious because "A generic disclosure renders a claimed species *prima facie* obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)". The claimed materials are known oxidizers and azole materials. With respect to the selectivity, it is the examiners position that although the reference fails to literally define this, this composition of the reference is expected to yield this property because the composition is the same (contains the same materials in the same amounts) and the same composition is expected to provide the same results absent evidence to the contrary.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.



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"A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

"A generic disclosure renders a claimed species prima facie obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)".

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

The references cited on the 1449 have been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

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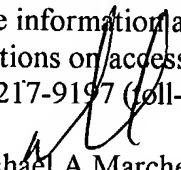
Any foreign language documents submitted by applicant has been considered to the extent of the short explanation of significance, English abstract or English equivalent, if appropriate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions or access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/04  
MM



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